

REMARKS

The last Office Action has been carefully considered.

It is noted that Claims 8, 9, 11, 13, 14, 18, 20 and 21 are rejected under 35 USC 102(b) over the U.S. patent to Rice.

Claims 3, 8, 9, 11, 13 and 18 are rejected under 35 USC 102(b) over the U.S. patent to Fox.

Claims 2, 4 and 10 are rejected under 35 USC 103(a) over the U.S. patent to Rice.

Claims 2, 4, 7, 10 and 12 are rejected under 35 USC 103(a) over the U.S. patent to Fox.

Also, the claims are objected to and rejected under 35 USC 112.

After carefully considering the Examiner's grounds for rejection of the claims, applicants amended Claims 18 and 20, the broadest independent claims, to more clearly define the present invention and to distinguish it from the prior art.

Before the analysis of the prior art it is believed to be advisable to explain the subject matter of the present invention and its new features.

The present invention deals with a power tool having a first operating switch for turning the power tool on and off and a second operating switch for turning the power tool on and off, and also means for mechanically coupling the switches with one another.

In accordance with the present invention the means for mechanically coupling these switches with one another is formed as a sheet element which is flexibly guided on a guiding surface formed as a slanted surface (Claim 18) or as a ramp (Claim 20) with a surface contact therebetween, or in other words with a surface contact between the flexible sheet element and the slanted surface or the ramp.

When the power tool is designed in accordance with the present invention, the guiding surface between the first and second operating switches serves for guiding the flexible element in a way that the two-dimensional element having a wide surface is in surface contact with the guiding surface.

The flexible element, being formed as a sheet element, composed for example of sheet metal, is able to transmit compressive forces as well as

tractive forces. Therefore, no spring elements are required in order to keep up a tension in the flexible element.

Turning now to the references applied by the Examiner, it is respectfully submitted that in the Fox reference a rod (48) connects the switches (19) and (49). A non-flexible rod is not comparable whatsoever to the flexible element formed as a sheet element, for example of sheet metal. The flexibility of the flexible element allows additional design features of the power tool which cannot be achieved when using a rigid rod disclosed in the patent to Fox.

It is therefore believed to be clear that this reference does not teach the new features of the present invention which are now defined in amended Claims 18 and 20.

The patent to Rice discloses a flexible connecting element (26) between the switches (5) and (7). However, the flexible element (26) is designed as a flexible wire or cable as explained in column 7, line 15. The wire or cable (27) is not a sheet element and is not able to transmit tractive forces. Therefore, in the patent to Rice additional spring elements are required to bias the switches (5) and (7) in opposite directions.

This reference also does not teach the new features of the present invention which are now defined in amended Claims 18 and 20.

The Examiner rejected the original claims over these references as being anticipated. In connection with this, it is believed to be advisable to cite the decision *In Re Lindenmann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir 1984) in which it was stated:

"Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim."

Definitely, the patents to Fox and Rice does not disclose each and every element of the power tool of the present invention which are now defined in Claims 18 and 20.

Therefore, the anticipation rejection should be considered as not tenable and should be withdrawn.

As explained hereinabove, the present invention also provides for the highly advantageous results which cannot be accomplished by the constructions disclosed in the references. It is well known that in order to support a valid rejection the art must also suggest that it would accomplish applicant's results. This was stated by the Patent Office Board of Appeals, in the case *Ex parte Tanaka, Marushima and Takahashi* (174 UPSQ 38), as follows:

Claims are not rejected on the ground that it would be obvious to one of the ordinary skill in the art to rewire

prior art devices in order to accomplish applicant's result, since there is no suggestion in prior art that such a result could be accomplished by so modifying prior art devices.

Also, the references do not contain any hint, suggestion, or motivation for the new features of the present invention. In order to arrive at the applicant's invention from the teachings of the references, the devices disclosed in the references have to be fundamentally modified and redesigned by including into them the new features of the present invention which are now defined in amended Claims 18 and 20. However, it is known that in order to arrive at a claimed invention by modifying the references, the cited art must itself contain a suggestion for such a modification.

This principle has been consistently upheld by the U.S. Court of Customs and Patent Appeals which, for example, held in its decision In Re Randol and Redford (165 USPQ 586) that:

Prior patents are references only for what they clearly disclose or suggest; it is not a proper use of a patent as a reference to modify its structure to one which prior art references do not suggest.

It is therefore believed that the obviousness rejection applied by the Examiner against the claims should also be considered as not tenable with respect to amended Claims 18 and 20 and should be withdrawn.

It is therefore respectfully submitted that Claims 18 and 20 should be considered as patentably distinguishing over the art and should be allowed.

As for the dependent claims, these claims depend on the dependent claims, they share their allowable features, and they should be allowed as well.

Reconsideration and allowance of the present application is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance; he is invited to telephone the undersigned (at 631-549-4700).

Respectfully submitted,



Michael J. Striker
Attorney for Applicant
Reg. No. 27233